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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,439	10/29/2003	Tomohiro Sakai	T36-159872M/KOH	4576
21254 7590 06/03/2008 MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817				
EXAMINER WEISS, HOWARD				
ART UNIT 2814		PAPER NUMBER		
MAIL DATE 06/03/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/695,439

**Applicant(s)**

SAKAI ET AL.

**Examiner**

Howard Weiss

**Art Unit**

2814

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-9,11,12 and 25-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-9,11,12 and 25-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Attorney's Docket Number: T36-159872M/KOH  
Filing Date: 10/29/2003  
Continuing Data: RCE established 5/21/2007  
Claimed Foreign Priority Date: 10/29/2002  
Applicant(s): Sakai et al. (Moriyama, Murakami, Shibata)

Examiner: Howard Weiss

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1 to 3, 5 to 9, 11, 12 and 25 to 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ota et al. (JP 04-085972 and translation submitted 5/10/2007) and Fujimoto et al. (U.S. Patent No. 6,2242,761).

Ota et al. shows most aspects of the instant invention (e.g. Figures 1 and Column 3 Lines 27 and 34) including an SiC device comprising a layer of p-type SiC **3**, an electrode **7** comprising first electrode material **4** in contact with said p-type SiC,

second electrode material **6** of Al and third material **5** of Ti located between said first and second materials.

Ota et al. do not explicitly disclose the first and second materials exhibiting an eutectic reaction at a temperature of 600 °C or less, the use of nickel instead of germanium as the first electrode material and the thicknesses stated. Fujimoto et al. teach (Column 7 Lines 25 to 36) that germanium and nickel are equivalent electrode materials known in the art and that these material show eutectic reactions at temperatures of 600 °C or less (i.e. 300 °C) to realize good contact resistance and easy wire bonding (Column 7 Lines 20 to 24). It would have been obvious to a person of ordinary skill in the art at the time of invention to use germanium instead of nickel and that these materials show eutectic reactions at temperatures of 600 °C or less to realize good contact resistance and easy wire bonding. Additionally, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of invention. See Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, 550 U.S. --, 82 USPQ2d 1385 (2007).

Since the Applicant has not established the criticality of the thicknesses stated and since these thicknesses are in common use in similar devices in the art (Fujimoto et al. give thicknesses between 20 to 50 nm and Ota et al. give thicknesses between 200 to 500 nm), it would have been obvious to one of ordinary skill in the art to use these values in the device of Ota et al. and Fujimoto et al. Where patentability is said to be based upon particular chosen dimensions or upon another variable recited in a claim, the applicant must show that the chosen dimensions are critical. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

***Response to Arguments***

3. Applicant's arguments filed 4/18/2007 have been fully considered but they are not persuasive. The Examiner's remarks in previous Office Actions still apply and are considered repeated herein. In reference to finding the proper ratio a material for the electrode, it has been held that when discovering an optimum value of a result effective variable involves only routine skill in the art effectually renders the invention obvious. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

In view of these reasons and those set forth in the present office action, the rejections of the stated claims stand.

***Conclusion***

4. Papers related to this application may be submitted directly to Art Unit 2814 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The Art Unit 2814 Fax Center number is **(571) 273-8300**. The Art Unit 2814 Fax Center is to be used only for papers related to Art Unit 2814 applications.
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Howard Weiss at **(571) 272-1720** and between the hours of 7:00 AM to 3:00 PM (Eastern Standard Time) Monday through Friday or by e-mail via [Howard.Weiss@uspto.gov](mailto:Howard.Weiss@uspto.gov). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy, can be reached on **(571) 272-1705**.
6. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

7. The following list is the Examiner's field of search for the present Office Action:

Field of Search	Date
U.S. Class / Subclass(es): 257/77, 781	thru 6/2/2008
Other Documentation: none	
Electronic Database(s): EAST	thru 6/2/2008

HW/hw  
4 June 2008

/Howard Weiss/  
Primary Examiner  
Art Unit 2814